

REMARKS/ARGUMENTS

Claims 1-18 are pending in the present application. Claim 18 has been cancelled. Claims 1-18 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point and distinctly claim the subject matter for which Applicant regards as the invention. Amendments as suggested by the Examiner have been made to claims 1, 9, and 14 to overcome this rejection. Claims 1-3, 6 and 8 are rejected under 35 U.S.C. § 102(b) as begin anticipated by Chen (U.S. Pat. No. 5,826,719). Claims 1-4, 6 and 8 are rejected under 35 U.S.C. § 103(e) as being anticipated by Pangerc et al. (U.S. Publ. No. 2004/0256265). Claims 1-4, 6 and 8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Banck (U.S. Pat. No. 2,265,336) in view of Mackie (U.S. Pat. No. 1,955,646). Claims 1-3, 6 and 8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Mackie. Claim 1-4, 6 and 8-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Pangerc in view of Omata et al. (U.S. Pat. No. 6,247,595). Claims 5 and 7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the art as applied to claims 1 and 6 and in further view of Huot Jr. et al. (U.S. Pat. No. 6,206,189). Claims 14-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Banck in view of Mackie and Blasko et al. (U.S. Pat. No. 5,228,590). Applicant sent this identical amendment to the Examiner in response to a final office action dated May 11, 2005. The Examiner did not enter this amendment for purposes of appeal as it raised new issues that would require further consideration or search. Applicant respectfully traverses all rejections.

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Independent claim 1 has been rejected under 35 U.S.C. § 102 as being anticipated by both Chen and Pangerc. Independent claim 1 has also been rejected under 35 U.S.C. § 103 as being unpatentable in view of multiple prior art combinations that include Banck in view of Mackie; Chen in view of Mackie; and Pangerc in view of Omata. In light of these multiple rejections Applicant has amended claim 1 to describe the insert as having a means for releasably securing the insert within the container and also describes the plurality of apertures within the insert as having slots that form a keyhole entry, sloped portions and support members extending upwardly from the slots of the plurality of apertures to facilitate holding punches. This amendment gains its antecedent basis from original claims 9 and 10, and from page 4 lines 9-10. None of the references cited against claim 1 teach an insert releasably within a container that have a plurality of apertures that have slots that form a keyhole entry, sloped portions and support members that extend upwardly from the slots of the plurality of apertures. Applicant will take each piece of prior art in turn.

The reference to Chen teaches an insert 20 that has apertures, however, those apertures do not have support members that extend upwardly from the slots to facilitate the holding of punches. The apertures are merely within the insert 20 and items can be placed therein.

Similarly, Pangerc does not teach a plurality of apertures in an insert that has a plurality of apertures with slots therein wherein support members extend upwardly from the slot of the plurality of apertures to facilitate to holding punches. Instead, Pangerc teaches a tool container with a bit holding portion 62 having a bore 80. (Para. 20). Pangerc, however, does not teach support members extending from the bores 80 and thus

does not meet all the limitations of amended claim 1. Additionally, Pangerc does not teach that an insert has first and second halves that are detachably joined together along a vertical parting plane. Instead, the insert 62 is just a solid body and does not separate.

The reference to Banck additionally does not teach an insert that has first and second halves detachably joined nor apertures having slots that form a keyhole entry, have sloped portions, and support members that extend upwardly from the slots of the plurality of apertures. Instead, Banck teaches an insert that is a slide drawer 12 that has an open compartment. This open compartment cannot be considered any of the identified limitations and therefore Banck does not teach and every element of the amended claim.

The reference to Mackie teaches a cigarette package that has a door 8 that is pivotally attached to the container, however, does not teach the use of an insert. Thus, Mackie does not teach the newly amended claim 1.

The reference to Omata teaches a flat tablet case having a hinge cap 50 within its sidewall and also does not have an insert. Thus, the amended claim is not anticipated by Omata.

Because the prior art references cited against claim 1 neither teach nor suggest an insert that has both two halves that are detachably joined together in combination with a plurality of apertures having slots that form a keyhole entry, sloped portions and support members extending upwardly from the slots of the plurality of apertures to facilitate holding punches the amended claim 1 is not anticipated by the prior art references. Additionally, a combination of these prior art references would not result in the claimed invention. At the very least the claimed combination would not have an insert with

a plurality of apertures having slots and support members extending upwardly from the slots to facilitate holding punches. For at least this reason amended claim 1 is considered novel and non-obvious and thus in allowable form.

Even if the Examiner believes each and every limitation of amended claim 1 is provided by the prior art, Applicant submits that there is no motivation to combine all of these prior art references as suggested by the Examiner in his 103 rejections nor would there be motivation to combine these references with other references to find amended claim 1 obvious. Specifically, as argued in the previous office action several of the cited prior art references are considered non analogous art by the Applicant. Specifically, in the last office action the Applicant argued: Claims 9-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Pangerc et al. in view of Omata. The Applicant asserts that the Examiner has failed to meet the burden of establishing a *prima facie* case of obviousness because the Omata reference is not analogous art and should not be considered in an obviousness analysis. The reference relied upon by the Examiner must either be in the field of the inventor's endeavor or reasonably pertinent to the specific problem with which the inventor was involved. In re Deminski, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986).

Further, the Omata reference relied upon by the Examiner is not in the Applicant's field of endeavor. When regarding the field of endeavor, the present invention deals particularly with a container for storing and transporting punches and dies. (Pg. 1, lines 16-17). In contrast, the Omata reference is directed toward a conventional case for carrying and dispensing refreshing tablets. (Col. 1, lines 12-13). The Omata reference is not directed toward nor does it discuss a container for

punches and dies. Consequently, the reference relied upon by the Examiner is not in the field of the inventors' endeavor and should not be relied upon.

Further, the Omata reference is not reasonably pertinent to the Applicant's problem. The Federal Circuit has clarified how to determine whether a reference is reasonably pertinent to the particular problem in which the endeavor was involved as follows:

[a] reference is reasonably pertinent if ... it is one which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering his problem. ... If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem. ... [I]f it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it.

In re Clay, 966 F.2d 656, 23 USPQ 2d 1058, 1060-61 (Fed. Cir. 1992). (Emphasis added); See also, MPEP § 2141.01(a). According to the Applicant's specification, the purpose of the present invention is to provide "a container that can securely hold the punches and dies while at the same time ensure the cleanliness of the equipment." (Pg. 1, lines 7-9). The purpose of the Omata reference is to "provide an inexpensive, flat tablet case comprising a relatively small number of parts and satisfactory in usability." (Col. 22-26).

The Applicant's reference has a different purpose as compared to that of the Omata reference. Specifically, Applicant's reference is for providing a container that not only securely holds punches and dies but also one that ensures cleanliness of the equipment, whereas the Omata reference is for providing an inexpensive, flat tablet case comprising a small number of parts. Therefore, Omata solves a different problem

than the claimed invention. Consequently, one skilled in the art would have less motivation or occasion to consider the reference cited by the Examiner. Because the reference relied upon by the Examiner is not in the field of the inventor's endeavor and is not reasonably pertinent to the specific problem with which the inventor was involved, the Omata reference is not analogous and should not be considered in an obviousness analysis.

Claims 14-18 are rejected under 35 U.S.C. § 103 as being unpatentable over Banck in view of Mackie and Blasko. Again, Applicant asserts that the Examiner has failed to meet the burden of establishing a *prima facie* case of obviousness because the Mackie and Banck references are not analogous art and should not be considered in an obviousness analysis. Specifically, neither of these references relied upon by the Examiner are in the field of the inventor's endeavor or reasonably pertinent to the specific problem with which the inventor was involved. In re Deminski, 230 USPQ 313, 315. The Banck and Mackie references relied upon by the Examiner are not in the Applicant's field of endeavor. When regarding the field of endeavor the present invention deals particularly with a container for storing and transporting punches and dies. (Pg. 1, lines 16-17). In contrast, the Banck reference is directed toward an improved cigarette and match dispenser. (Col. 1, lines 1-2). The Mackie reference is directed toward a cigarette package with an improved structure. (Col. 1, lines 1-3). Thus, Banck and Mackie references are not directed toward nor do they discuss a container for storing and transporting punches and dies. Consequently, these references relied upon by the Examiner are not in the field of the inventor's endeavor and should not be relied upon.

The Banck and Mackie references likewise are not reasonably pertinent to Applicant's problem. According to Applicant's specification, the purpose of the present invention is to provide "a container that can securely hold the punches and dies while at the same time ensure the cleanliness of the equipment". According to Banck, the device is "for the purpose of dispensing cigarettes and matches." (Col. 1, lines 4-5). The purpose of Mackie is to provide "means to permit vision of a portion of the cigarettes within the package adjacent to the cigarette discharge mechanism." Col. 1, lines 6-12).

The Applicant's reference has a different purpose as compared to the Banck and Mackie references. Specifically, the Applicant's reference is for a container that can securely hold the punches and dies while at the same time ensure the cleanliness of the equipment, whereas the Banck reference is for providing a device that dispenses cigarettes and matches, and the Mackie reference is for a means to permit vision of a portion of the cigarettes with the package adjacent to the cigarette discharge mechanism. Therefore, Banck and Mackie solve different problems than the claimed invention. Consequently, one skilled in the art would have less motivation or occasion to consider the references cited by the Examiner. Because the references relied upon by the Examiner are not in the field of the inventor's endeavor and are not reasonably pertinent to the specific problem with which the inventor is involved, the Banck and Mackie references are not analogous and should not be considered in an obviousness analysis.

Even if the Examiner, in light of these arguments, believes that the Omata, Banck, and Mackie references are analogous art, at the very least, because these references relied upon by the Examiner are not in the field of the inventor's endeavor nor

reasonably pertinent to this specific problem with which the inventor was involved, one skilled in the art would have less motivation to consider these references when combining the prior art. None of the prior art references cited by the Examiner deal specifically with the problem of holding punches in an upright position. A punch is a very specialized tool and the reason for having the apertures having slots that form a keyhole entry, sloped portions and support members extending upwardly from the slots of the plurality of apertures is to specifically facilitate the holding of the special tool that is a punch. Because the problem of holding this specific tool in an upright position is not present in any of the prior art references; the motivation to combine multiple prior art references to form an insert that facilitates holding punches is found in the Applicant's specification. Thus, Applicant asserts that the Examiner is using the Applicant's specification as a blueprint to create the claimed device. For the reasons stated above Applicant believes that the amendment to claim 1 overcomes all of the Examiner's objections to claim 1. Additionally, claims 2-8 depend on claim 1 and for at least this reason are also considered in allowable form.

Similarly, independent claim 9 has been amended such that the insert of claim 9 contains all the limitations of the insert of claim 1 and therefore this amendment to the claim overcomes all 103 rejections. Claims 11-13 depend on claim 9 and for at least this reason are also considered in allowable form.

Claims 14-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Banck in view of Mackie. Claim 18 is partially amended into claim 14 and has thus been cancelled. Applicant has amended claim 14 to add the limitations of "wherein each housing has a lid that has notches therein and a

bottom having protrusions that extend downwardly from the bottom wall such that the notches on the lid of the housing receive the protrusions from another housing to facilitate stacking of one container on top of another; and wherein at least one housing has dowels that extend outwardly from the sidewall of the housing that are received by openings in the sidewall of another housing." This amendment gains its antecedent basis from page 5, lines 32-35 that states "likewise, notches 28 on the lid 24 are of one housing 12 receive the protrusions 22 of another housing can facilitate stacking of one container on top of another," and from page 4, lines 19-25 that states "while the housings 12 can be joined in any conventional manner, preferred is the use of a clasp and a pair of dowels 78 that extend outwardly from the sidewall 14 of a housing 12. The clasp 76 is received in a retaining slot 80 located on the sidewall 14 of a separate housing 12 and the dowel 78 are received in openings 82." Thus, no new matter has been added to claim 14.

Neither Mackie nor Blasko teaches these connections. Specifically, Mackie is merely a cigarette package and does not teach a manner in which other cigarette packages can be attached to other cigarette packages. The reference to Blasko teaches the interlocking of cartons that is accomplished by a pin in corresponding positioned holes or a track and rail, or a mortise and tenon, however, Blasko does not teach a lid element that has notches thereon to receive protrusions of a bottom surface of the carton. (Col. 4, lines 45-50). Therefore, the combination of Blasko and Mackie would not provide a device with a lid having notches therein so that a second item could be stacked on top of the first item. Thus, each and every limitation is not met and the obvious rejection is considered overcome.

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Even if the Examiner considers each and every limitation of the claimed invention present as argued above, Applicant still asserts that Mackie is not analogous art. Additionally, even if Mackie is analogous art, at the very least, there would be less motivation of one skilled in the art to combine Mackie with Blasko to arrive at the claimed invention. Thus, because there is no motivation to combine the prior art references, Applicant believes the rejection overcome. Claims 15-17 depend on claim 14 and for at least this reason are also considered in allowable form.

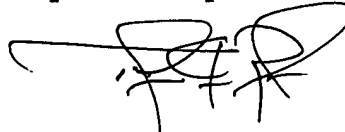
CONCLUSION

In view of the above remarks and arguments, Applicant believes that claims 1-17 are in condition for allowance and Applicant respectfully requests allowance of such claims.

If any issues remain that may be expeditiously addressed in a telephone interview, the Examiner is encouraged to telephone the undersigned at 515/558-0200.

All fees or extensions of time believed to be due in connection with this response are attached hereto; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-2098.

Respectfully submitted,



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